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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/914,033
Filing Date: August 22, 2001
Appellant(s): KOBAYASHI ET AL.

Lee Cheng
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 5, 2006 appealing from the Office action mailed August 10, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application No. 10/832,279, which is a continuation of Application No. 09/914,033, has an appeal brief which was filed February 21, 2007 appealing the Office action mailed September

01, 2006. The response to this appeal brief was submitted January 8, 2008 and is currently pending before the Board of Appeals.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,576,344 Sasaki et al 03-1986

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki et al (U.S. Patent No. 4,576,344).

With respect to Claims 1-3 and 16-18, note that Sasaki et al teach a polyester film roll free from wrinkles. Therefore, the difference R between the minimum diameter value is not more than $2W \times 10^{-3}$ because the width of the roll is uniform throughout the roll and such is the case for the condition $L \times 10^{-7}$.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-15 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al as applied to claims 1-2 and 16-17 above.

Sasaki et al do not mention the specific dimensions in term of rolling hardness or flexural modulus etc. However, it would have been an obvious matter of design choice, as determined through routine experimentation and optimization, to dimension the polyester film roll of Sasaki et al as specified in Claims 4-15 and 19-24 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

(10) Response to Argument

With respect to appellants' remarks on pages 4-5, it is the appellants position that the examiner's arguments are flawed because the invention focuses on the difference between maximum and minimum diameter values and that Sasaki et al do not address the deformities.

In the instant case, it should be noted that Sasaki et al do teach maximum and minimum diameters because all circular articles have diameters. The only difference is that in the Sasaki et al reference the difference between the maximum and minimum diameters equal zero.

Therefore, the minimum diameter is not more $2W \times 10^{-3}$ and not more than $L \times 10^{-7}$.

Further, appellants, on page 5, line 14, readily admit, "*Sasaki et al only teach a polyester film roll free from wrinkles*". Why would Sasaki et al have to "*address the deformities*", as stated by appellants on Page 5, line 16, when there are no deformities in the roll of Sasaki et al?

With respect to appellants' remarks on the last paragraph of page 5 and relying upon inherency it is the applicants' position that the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art.

The Sasaki et al reference clearly teaches a polyester roll free from wrinkles and discusses the merits of such rolls. See, for example, Column 5, lines 17-27. It is well known in the art, and intuitively apparent, that a wrinkle free roll would have a uniform diameter along its width. Thus, the claim limitation defining a maximum ("not more than") difference between the maximum and minimum diameters is met because zero is less than the defined maximum. Therefore, the examiner has provided a basis in fact and a line of technical reasoning which show that the minimum diameter is not more $2W \times 10^{-3}$ and not more than $L \times 10^{-7}$. Further, if it is still the appellant's position that Sasaki does not meet the limitation, then applicant must provide factual evidence, such as test results, as to why Sasaki et al do not meet the claim. Mere allegations that the claim is not met are insufficient absent such factual evidence.

With respect to the limitation "*wherein the first maximum perpendicular line length is not more than 300 micro-meters*", it should be noted that it appears that appellants are claiming the graph shown in Figure 6. This is considered to be a product-by-process claim. In this type of claims, determination of patentability is based on the product itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Therefore, applicants are merely claiming a polyester film roll having a plurality of diameters.

With respect to appellant's remarks at the bottom of page 10 and the Sasaki et al reference, it should be noted that Sasaki et al do approach the problem in a different way, i.e., controlling the roll hardness while the instant invention measures the variations in the roll diameter. While the Sasaki et al and instant invention use different approaches, the end result (a

wrinkle-free roll) is the same. Therefore the diameter limitation would also be met based on the inherency reasoning advanced above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William A Rivera/
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